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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,880	11/30/2000	Chyi-Cheng Chen	20223 US (C38435/120240)	1470

7590

12/17/2002

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EXAMINER

WARE, TODD

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/726,880

Applicant(s)

CHEN ET AL.

Examiner

Todd D Ware

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 18-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt of response and amendment filed 9-24-02 is acknowledged. Claim 1 has been amended and claim 2 has been canceled as requested. Claims 1 and 3-27 are pending.

### ***Election/Restrictions***

1. This application contains claims 16 and 18-27 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 and 3-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Leuenberger (EP 0 565 989; hereafter '989) –US 5,668,183 is relied upon as a translation of '989.**

'989 discloses gelatin or gum arabic powder compositions for vitamins where the powder composition has a particle size within the instant range. '989 also discloses the instant vitamins and ranges/amounts of ingredients.

***Response to Arguments***

4. Applicant's arguments filed 9-24-02 have been fully considered but they are not persuasive. Applicant argues that amendment of the claims to recite "consisting essentially of" language overcomes the instant rejection since the cited art includes a lignin as the matrix component. However, for purposes of searching for and applying prior art under 35 U.S.C. 102, "consisting essentially of" is construed as equivalent to "comprising" (MPEP 2111.03). Furthermore, applicant has the burden of showing that the introduction of additional steps or components are detrimental to applicant's invention. Accordingly, since applicant has not provided any such evidence or data, applicant's argument is not found persuasive. Applicant also argues, "the examiner has made no findings of fact to determine what, if anything, was added to or subtracted from the EP publication when it was filed in the U.S." and that the rejection is made upon the hope or belief that '183 and '989 disclose the same subject matter. Regardless of the language a reference is published in, when an Examiner has set forth a rejection based upon the examiner's best understanding of what the reference discloses, the burden is upon the applicant to demonstrate that the reference does not disclose what the Examiner sets forth (35 U.S.C. 102(b), MPEP 706.02, and 901.05). Accordingly, this argument is not found persuasive.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**7. Claims 1 and 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leuenberger (EP 0 565 989; hereafter '989) –US 5,668,183 is relied upon as a translation of '989.**

'989 teaches gelatin or gum arabic powder compositions for vitamins where the powder composition has a particle size within the instant range. '989 also discloses the instant vitamins and ranges/amounts of ingredients. '989 does not teach the moisture content of the powder, however it would have been obvious to one skilled in the art at the time of the invention to achieve the instant moisture content based upon the motivation of insuring dryness and good flowability.

#### ***Response to Arguments***

8. Applicant's arguments filed 9-24-02 have been fully considered but they are not persuasive. Applicant argues that the rejection under 35 U.S.C. 103(a) is improper for

the same reasons set forth above under 35 U.S.C. 102(b) -the instant claims have been amended to recite "consisting essentially of" language and this allegedly overcomes the instant rejection since the cited art includes a lignin as the matrix component. However, for purposes of searching for and applying prior art under 35 U.S.C. 103, "consisting essentially of" is construed as equivalent to "comprising" (MPEP 2111.03).

Furthermore, applicant has the burden of showing that the introduction of additional steps or components are detrimental to applicant's invention. Accordingly, since applicant has not provided any such evidence or data, applicant's argument is not found persuasive. Applicant also argues, "the examiner has made no findings of fact to determine what, if anything, was added to or subtracted from the EP publication when it was filed in the U.S." and that the rejection is made upon the hope or belief that '183 and '989 disclose the same subject matter. Regardless of the language a reference is published in, when an Examiner has set forth a rejection based upon the examiner's best understanding of what the reference discloses, the burden is upon the applicant to demonstrate that the reference does not disclose what the Examiner sets forth (35 U.S.C. 102(b), MPEP 706.02, and 901.05). Accordingly, this argument is not found persuasive.

Applicant further argues that the Examiner has not met the burden for obviousness regarding achievement of the moisture content of instant claim 15 and that an "obvious to achieve" standard has been relied upon and that the Examiner has provided motivation, or suggestion to modify the instant reference. This argument is not found persuasive. '989 teaches that dry powders are achieved. Instant claim 15

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requires a particular moisture content, however, the ultimate effect is that the same dry powder as '989 results. Also, applicant has not provided any data demonstrating any criticality to the requirement that the moisture content is between 1 and 4% and such a moisture content does not appear to provide any surprising, non-obvious, or critical difference from the phrase "dry powder." In any event, '989 teaches that dry powders have good flowability (see C 4, L 40-45 of '183). Accordingly, it is the position of the Examiner that as the dryness of the powder increases, so must the flowability as taught in the reference. Accordingly, it would have been obvious to one skilled in the art at the time of the invention to achieve the instant moisture content based upon the motivation of insuring dryness and good flowability.

**9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leuenberger (EP 0 565 989; hereafter '989) –US 5,668,183 is relied upon as a translation of '989- in view of Finnan et al (4,830,859; hereafter '859).**

'989 is relied upon for all that it teaches as stated previously. '989 does not teach incorporating the powder into tablets.

'859 teaches formation of vitamin powder into tablets.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to form the powder of '989 into tablets with the motivation of providing a convenient dosage form for administration of the vitamin.

***Response to Arguments***



10. Applicant's arguments filed 9-24-02 have been fully considered but they are not persuasive. Applicant argues that the rejection under 35 U.S.C. 103(a) is improper for the same reasons *supra* (paragraph 8) and that '859 does not remedy these deficiencies. Accordingly the response to arguments of paragraph 8 are again relied upon here.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

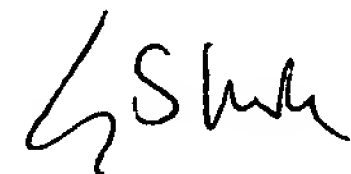
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on M-F, 8:00 AM - 4:30 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Gollamudi S. Kishore, PhD  
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tw  
December 10, 2002